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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/214,155 12/29/98 TAKAYAMA

H 052816

HM22/1004
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EXAMINER

QAZI, S

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

10/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/214,155

Applicant(s)
Hiroaki Takayama et al.

Examiner
Sabiha Qazi

Group Art Unit
1616



☒ Responsive to communication(s) filed on Aug 28, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3 and 4 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 3 and 4 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Continued Prosecution Application

The request filed on 8/28/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/214,155 is acceptable and a CPA has been established. An action on the CPA follows.

Status of the Application

Claims 3 and 4 are pending and are rejected.

No claim is allowed.

Applicant,s response and declaration filed in paper no.18, dated 8/28/00 is hereby acknowledged. Amendments file in paper no. 9B, dated 8/4/00 are partially entered. New claims 3 and 4 are entered however, amendment in specification by inserting a the synthetic scheme on page 32 is not entered. It constitutes new matter. Since the criticality of the invention is the difference in configuration the amendment in specification will not be entered.

Rejection Withdrawn

1. Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto et al. (US Patent 5,877,168) and claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over

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Trost M. Barry et al. (J. Am. Chem. Soc., Vol. 114, No. 25, (1992), pages 9836-45) is maintained.

The declaration filed by applicants has been considered, instant invention with 20(S) show better results however, the concentration of each compound compared is not the same. Applicant is requested to explain that the concentration used is different in various cases.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 2 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 and 4 of copending Application No.

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09/068219. Although the conflicting claims are not identical, they are not patentably distinct from each other.

It was noted by the Examiner that applicant's copending application 09/214,155 contains the same invention as claimed in this instant application 09/068,219. In the instant applications applicants are claiming 20-S compounds whereas in 09/068,219 the compound with 20-R are claimed. These compounds are considered obvious over the other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabiha N. Qazi, whose telephone number is (703) 305-3910. The examiner can normally be reached on Monday through Friday from 8 a.m. to 6 p.m. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



Sabiha N. Qazi Ph.D.

9/29/00

Primary Examiner, Art Unit 1616